

REMARKS

Claims 1-30 were pending in the Application. Claims 1-2, 9-12, 19-22 and 29-43 are cancelled without prejudice or disclaimer and hence claims 3-8, 13-18 and 23-28 are pending. Applicants reserve the right to file a continuation patent application to capture the subject matter of cancelled claims 1-2, 9-12, 19-22 and 29-30. Applicants further reserve the right to file a divisional patent application to capture the subject matter of cancelled claims 31-43.

Further, Applicants amended claims 3, 6, 7, 8, 13, 16, 17, 18, 23, 26, 27 and 28 as indicated above. Claims 3, 6, 7, 8, 13, 16, 17, 18, 23, 26, 27 and 28 were not amended to overcome prior art but to be rewritten in independent form. Hence, no prosecution history estoppel arises from the amendments to claims 3, 6, 7, 8, 13, 16, 17, 18, 23, 26, 27 and 28. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 3, 6, 7, 8, 13, 16, 17, 18, 23, 26, 27 and 28 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Claims 1-5, 11-15 and 21-25 are rejected under 35 U.S.C. §102(e). Claims 6-10, 16-20 and 26-30 are rejected under 35 U.S.C. §103(a).

Applicants address these rejections below.

Applicants' attorney left a voice message with the Examiner on November 3, 2006 but did not hear back from the Examiner.

I. REJECTIONS UNDER 35 U.S.C. §102(e):

The Examiner has rejected claims 1-5, 11-15 and 21-25 under 35 U.S.C. §102(e) as being anticipated by Burnhouse et al. (U.S. Patent Application Publication No. 2002/0056104) (hereinafter "Burnhouse"). Applicants have cancelled claims 1-2, 11-12 and 21-22 and therefore the rejections to claims 1-2, 11-12 and 21-22 under 35 U.S.C. §102(e) are moot. Applicants respectfully traverse the rejections of claims 3-

5, 13-15 and 23-25 under 35 U.S.C. §102(e) as being anticipated by Burnhouse for at least the reasons stated below.

For a claim to be anticipated under 35 U.S.C. §102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. §2131.

Applicants respectfully assert that Burnhouse does not disclose "wherein if said broadcast signals include said tags then the method further comprises the step of: comparing said tags with a list of one or more classifications associated with said plurality of television stations" as recited in claim 3 and similarly in claims 13 and 23. The Examiner cites paragraphs [0036 and 0040] of Burnhouse as disclosing the above-cited claim limitation. Office Action (8/18/2006), page 3. Applicants respectfully traverse.

Burnhouse instead discloses that CPU 29 generates a table of pointers 401 to the EPG stored in the memory. [0036]. Burnhouse further discloses that the table 401 is used for changing the order of channels or programs according to the information to be presented in the guide to the user. [0036]. Burnhouse additionally discloses that using the information downloaded from the satellite transmission, programming and channel selection information is provided to the viewer. [0040]. Hence, Burnhouse discloses a table of pointers used for changing the order of channels to be presented in a guide to a user. Further, Burnhouse discloses providing programming and channel selection information using the information downloaded from the satellite transmission. There is no language in the cited passages that discloses comparing tags with a list of one or more classifications. Applicants respectfully request the Examiner to particularly point out in Burnhouse where Burnhouse allegedly discloses a list of classifications that is compared with tags pursuant to 37 C.F.R. §1.104(c)(2). Further, there is no language in the cited passages that discloses comparing tags with a list of one or more classifications associated with a plurality of television stations. Neither is there any language in the cited passages that discloses comparing tags with a list of one or more classifications associated with a plurality of television stations if the broadcast signals include the

tags. Thus, Burnhouse does not disclose all of the limitations of claims 3, 13 and 23, and thus Burnhouse does not anticipate claims 3, 13 and 23. M.P.E.P. §2131.

Claims 4-5, 14-15 and 24-25 each recite combinations of features of independent claims 3, 13 and 23, respectively, and hence claims 4-5, 14-15 and 24-25 are not anticipated by Burnhouse for at least the above-stated reasons that claims 3, 13 and 23, respectively, are not anticipated by Burnhouse. Claims 4-5, 14-15 and 24-25 recite additional features, which, in combination with the features of the claims upon which they depend, are not anticipated by Burnhouse.

For example, Burnhouse does not disclose "wherein said one or more folders associated with said one or more classifications for said plurality of television stations on said display are displayed according to a base set if there are no differences between said list of one or more classifications associated with said plurality of television stations and said tags" as recited in claim 4 and similarly in claims 14 and 24. The Examiner cites Figures 3 and 5 and paragraph [0041] of Burnhouse as disclosing the above-cited claim limitation. Office Action (8/18/2006), page 3. Applicants respectfully traverse.

Burnhouse instead discloses that at step 501, a folder-style guide is generated and presented to the user. [0041]. Burnhouse further discloses that the folder-style guide may display several folders, each folder representative of a different type or category of program. [0041]. Burnhouse additionally discloses that in one embodiment, the designated folder may have a title that indicates the type of program in the folder such as drama, sports, etc. [0041]. Hence, Burnhouse discloses displaying folders, where each folder is representative of a category or type of program. There is no language in the cited passage or in the description of Figures 3 and 5 that discloses that folders associated with one or more classifications for a plurality of television stations on the display are displayed according to a base set. Neither is there any language in the cited passage or in the description of Figures 3 and 5 that discloses that folders associated with one or more classifications for a plurality of television stations on the display are displayed according to a base set if there are no differences between the list of one or more classifications associated with

the plurality of television stations and the tags. Thus, Burnhouse does not disclose all of the limitations of claims 4, 14 and 24, and thus Burnhouse does not anticipate claims 4, 14 and 24. M.P.E.P. §2131.

Applicants further assert that Burnhouse does not disclose "wherein if there are differences between said list of one or more classifications associated with said plurality of television stations and said tags then the method further comprises the steps of: updating said list of one or more classifications associated with said plurality of television stations to become a new base set" as recited in claim 5 and similarly in claims 15 and 25. The Examiner cites paragraph [0036] of Burnhouse as disclosing the above-cited claim limitation. Office Action (8/18/2006), page 4. Applicants respectfully traverse and assert that Burnhouse instead discloses that CPU 29 generates a table of pointers 401 to the EPG stored in the memory. [0036]. Burnhouse further discloses that the table 401 is used for changing the order of channels or programs according to the information to be presented in the guide to the user. [0036]. Hence, Burnhouse discloses a table of pointers where the table is used for changing the order of channels or programs. There is no language in the cited passage that discloses updating a list of one or more classifications. Instead, Burnhouse simply discloses changing the order of channels. Neither is there any language in the cited passage that discloses updating a list of one or more classifications associated with the plurality of television stations to become a new base set. Neither is there any language in the cited passage that discloses updating a list of one or more classifications associated with the plurality of television stations to become a new base set if there are differences between the list of one or more classifications associated with the plurality of television stations and the tags. Thus, Burnhouse does not disclose all of the limitations of claims 5, 15 and 25, and thus Burnhouse does not anticipate claims 5, 15 and 25. M.P.E.P. §2131.

Applicants further assert that Burnhouse does not disclose "wherein if there are differences between said list of one or more classifications associated with said plurality of television stations and said tags then the method further comprises the steps of:... displaying one or more folders associated with one or more classifications for said plurality of television stations on said display according to said new base set"

as recited in claim 5 and similarly in claims 15 and 25. The Examiner cites Figures 9-10 of Burnhouse as disclosing the above-cited claim limitation. Office Action (8/18/2006), page 4. Applicants respectfully traverse and assert that there is no language in the description of Figures 9 and 10 that discloses displaying folders associated with classifications for the television stations on the display according to the new base set. Thus, Burnhouse does not disclose all of the limitations of claims 5, 15 and 25, and thus Burnhouse does not anticipate claims 5, 15 and 25. M.P.E.P. §2131.

As a result of the foregoing, Applicants respectfully assert that not each and every claim limitation was found within Burnhouse, and thus claims 3-5, 13-15 and 23-35 are not anticipated by Burnhouse. M.P.E.P. §2131.

II. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 6-9, 16-19 and 26-29 under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Rashkovskiy et al. (U.S. Patent Application Publication No. 2004/0034867) (hereinafter "Rashkovskiy"). The Examiner has further rejected claims 10, 20 and 30 under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Rashkovskiy and in further view of McKenna Jr. (U.S. Patent Application Publication No. 2003/0018971). Applicants cancelled claims 9-10, 19-20 and 29-30. Hence, the rejections to claims 9-10, 19-20 and 29-30 are moot. Applicants address the rejections to the remaining pending claims (claims 6-8, 16-18 and 26-28) below.

A. Claims 6-8, 16-18 and 26-28 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Burnhouse in view of Rashkovskiy.

1. Burnhouse and Rashkovskiy, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Burnhouse and Rashkovskiy, taken singly or in combination, do not teach or suggest "wherein said one or more folders associated with said one or more classifications for said plurality of television stations on said display are displayed according to a base set if said broadcast signals do not

include said tags" as recited in claim 6 and similarly in claims 16 and 26. The Examiner cites Figures 9 and 10 of Burnhouse as teaching one or more folders associated with one or more classifications for the plurality of television stations on the display. Office Action (8/18/2006), page 5. The Examiner further cites paragraph [0020] of Rashkovskiy as teaching displaying folders according to a base set if the broadcast signals do not include the tags. *Id.* Applicants respectfully traverse.

Rashkovskiy instead teaches that the user has selected favorite programs that are currently available in the illustrated example. [0020]. Rashkovskiy further teaches that the basis for defining favorites may be extremely varied. [0020]. Rashkovskiy additionally teaches that the user may simply enter what the user decides at any given instance of time, such as any given day of the week, are his or her favorite programs. [0020]. Furthermore, Rashkovskiy teaches that as another example, the system can automatically discern what are the favorite programs on how frequently the user views a given program over varying time periods. [0020]. Hence, Rashkovskiy teaches allowing the user to select his/her favorite programs. There is no language in the cited passage that teaches displaying folders according to a base set. Neither is there any language in the cited passage that teaches displaying folders according to a base set if the broadcast signals do not include the tags. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 6, 16 and 26, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Burnhouse and Rashkovskiy, taken singly or in combination, do not teach or suggest "receiving input to add or delete a particular folder; and adding or deleting said particular folder" as recited in claim 7 and similarly in claims 17 and 27. The Examiner cites Figure 6 and paragraph [0014] of Rashkovskiy as teaching the above-cited claim limitation. Office Action (8/18/2006), page 6. Applicants respectfully traverse and assert that Rashkovskiy instead teaches a graphical user interface 10 for implementing an electronic content guide that includes a plurality of selectable category icons 12 represented as "virtual" file folders. [0014]. Rashkovskiy further teaches that each category icon 12 may be pre-defined or may be user definable. [0014]. Rashkovskiy additionally teaches that category

icon 12a is provided for favorite programs, 12b for movies, 12c for currently available programs, 12d for programs available in the next hour, 12e for sports programs, 12f for news and 12g for animal related content. [0014]. Hence, Rashkovskiy teaches an electronic content guide that includes selectable category icons represented as "virtual" file folders. There is no language in the description of Figure 6 or in the cited passage that teaches receiving input to add or delete a particular folder. Neither is there any language in the description of Figure 6 or in the cited passage that teaches adding or deleting a particular folder. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 7, 17 and 27, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Burnhouse and Rashkovskiy, taken singly or in combination, do not teach or suggest "receiving input to add or delete an indication associated with a particular television station associated with a particular folder; and adding or deleting said indication associated with said particular television station associated with said particular folder" as recited in claim 8 and similarly in claims 18 and 28. The Examiner states that claim 8 is rejected for the same rationale as the rejection to claim 6. Office Action (8/18/2006), page 6. Hence, Applicants assume that the Examiner is citing paragraph [0020] of Rashkovskiy as teaching the above-cited claim limitations. Applicants respectfully traverse.

Rashkovskiy instead teaches that the user has selected favorite programs that are currently available in the illustrated example. [0020]. Rashkovskiy further teaches that the basis for defining favorites may be extremely varied. [0020]. Rashkovskiy additionally teaches that the user may simply enter what the user decides at any given instance of time, such as any given day of the week, are his or her favorite programs. [0020]. Furthermore, Rashkovskiy teaches that as another example, the system can automatically discern what are the favorite programs on how frequently the user views a given program over varying time periods. [0020]. Hence, Rashkovskiy teaches allowing the user to select his/her favorite programs. There is no language in the cited passage that teaches receiving input to add or delete an indication associated with a particular television station. Neither is there any

language in the cited passage that teaches receiving input to add or delete an indication associated with a particular television station associated with a particular folder. Neither is there any language in the cited passage that teaches adding or deleting the indication associated with the particular television station. Neither is there any language in the cited passage that teaches adding or deleting the indication associated with the particular television station associated with the particular folder. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 8, 18 and 28, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2. Examiner's motivation for modifying Burnhouse with Rashkovskiy to include the missing limitation of claims 6, 16 and 26 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).



The Examiner admits that Burnhouse does not teach displaying folders according to a base set if the broadcast signals do not include the tags, as recited in claim 6 and similarly in claims 16 and 26. Office Action (8/18/2006), page 5. The Examiner asserts that Rashkovskiy teaches the above-cited claim limitation. *Id.* The Examiner's motivation for modifying Burnhouse with Rashkovskiy to include the above-cited claim limitation is "for the purpose of better organizing the available content for easier selection and viewing (see Paragraph 0006 of Rashkovskiy)." *Id.* The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 6, 16 and 26.

The Examiner's motivation ("for the purpose of better organizing the available content for easier selection and viewing") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Burnhouse to include the missing claim limitations of claims 6, 16 and 26. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6, 16 and 26. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Burnhouse addresses the problem of generating a folder guide to generate tailored broadcast system electronic program guides. [0005]. The Examiner has not provided any reasons as to why one skilled in the art would modify Burnhouse (which teaches generating a folder guide to generate tailored broadcast system electronic program guides) to display folders according to a base set if the broadcast signals do not include the tags (missing claim limitation of Burnhouse). The Examiner's motivation ("for the purpose of better organizing the available content for easier selection and viewing") does not provide such reasoning.

The Examiner's motivation is simply the need expressed in Rashkovskiy. Rashkovskiy teaches that there is a need for an electronic content guide that better organizes the available content for easier selection and viewing. [0006]. Why would the reason to modify Burnhouse (which teaches generating a folder guide to generate tailored broadcast system electronic program guides) to display folders according to a base set if the broadcast signals do not include the tags (missing claim limitation) be

to better organize the available content for easier selection and viewing? How does displaying folders according to a base set if the broadcast signals do not include the tags relate to organizing the available content for easier selection and viewing? Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Burnhouse to include the missing claim limitation of claims 6, 16 and 26. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 6, 16 and 26. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

III. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 3-8, 13-18 and 23-28 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Applicants

By: \_\_\_\_\_

Robert A. Voigt, Jr.  
Reg. No. 47,159

P.O. Box 50784  
Dallas, TX 75201  
(512) 370-2832